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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,385	05/16/2001	Donald R. Ryan	D/A0477Q3	3417

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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/858,385

Applicant(s)

RYAN ET AL.

Examiner

Laurie Ries

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/5/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Request for Continued Examination, filed 3 February 2006, to the original application, filed 16 May 2001.
2. The rejection of claims 1-2 and 8-11 under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1) has been withdrawn as necessitated by amendment and newly found prior art.
3. The rejection of claims 3-7 under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1) and Yankovich (U.S. Patent 6,704,906 B1) has been withdrawn as necessitated by amendment and newly found prior art.
4. Claims 1-11 and 36-37 are pending. Claims 12-35 have been withdrawn. Claim 1 is an independent claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1) and Matsuo (U.S. Patent 6,775,729 B1).

As per claims 1 and 2, Tonkin discloses a controller for a document production system including a method for associating electronic data files to particular document components of a job including identifying a document component node for each operation in a document, such as printed pages and the like (See Tonkin, Figure 6, element 500, and Page 5, paragraph 0068).

Tonkin also discloses creating sub-nodes, or sub-objects, associated to a parent node (See Tonkin, Page 5, paragraphs 0068-0070). Tonkin also discloses associating an electronic data file with a document component node (See Tonkin, Figure 5B, element 312, and Page 4, paragraphs 0054-0056).

Tonkin does not disclose expressly retrieving the capabilities and constraints of printers and finishers, mapping all generic document forms, and selecting one of a set of document forms to apply to the document. Matsuo discloses retrieving the functions and limitations of printers and finishers (See Matsuo, Column 11, lines 4-36) and

mapping generic document forms represented by Type ID's (See Matsuo, Column 11, lines 22-26, and Figure 18).

Tonkin and Matsuo are analogous art because they are from the same field of endeavor of processing documents.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the mapping of document forms and retrieval of printer and finisher capabilities of Matsuo with the document production system of Tonkin. The motivation for doing so would have been to dynamically select the print engine or finisher based upon the job type being performed.

Allen discloses a set of document forms that can be applied to documents, which shows, by way of example, seven different forms, including locations of folds, binding details, paper size, trimming details, number of pages in each document, page numbers of individual pages in a sequence, paper thickness, etc (See Allen, Column 3, lines 12-27).

Tonkin, Matsuo and Allen are analogous art because they are from the same field of endeavor of processing documents.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the selection of a document form of Allen with the Type ID of Tonkin and Matsuo. The motivation for doing so would have been to identify the data type for the document form and thereby map the assignment of said document form to the appropriate device. Therefore, it would have been obvious to combine Matsuo and Allen with Tonkin for the benefit of identifying the data type for the document form and

thereby dynamically select the print engine or finisher based upon the document form to obtain the invention as specified in claims 1 and 2.

As per claim 8, Tonkin, Matsuo, and Allen disclose the limitations of claim 1 as described above. Tonkin also discloses prompting a user to classify the document as one of a set including a variable component and a static component (See Tonkin, Pages 5-6, paragraphs 0070-0071 and 0073-0075).

As per claim 9, Tonkin, Matsuo, and Allen disclose the limitations of claim 8 as described above. Tonkin also discloses prompting the user to designate data address information to enable accessing of variable data during processing of the variable component (See Tonkin, Figure 5D, elements 382 and 385, and Page 5, paragraph 0061).

As per claim 10, Tonkin, Matsuo, and Allen disclose the limitations of claim 1 as described above. Tonkin also discloses allowing a user to classify the document component as one of a set including an external component and an internal component, as shown by Tonkin as production components and document components, respectively (See Tonkin, Figure 6, and Page 6, paragraph 0076).

As per claim 11, Tonkin, Matsuo, and Allen disclose the limitations of claim 10 as described above. Tonkin also discloses prompting the user for an integrity descriptor for the external component (See Tonkin, Figure 5D, elements 382 and 385, and Page 5, paragraph 0061).

6. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1) and Matsuo (U.S. Patent 6,775,729 B1) as applied to claim 1 above, and further in view of Yankovich (U.S. Patent 6,704,906 B1).

As per claim 3, Tonkin, Matsuo, and Allen disclose the limitations of claim 1 as described above. Tonkin, Matsuo, and Allen do not disclose expressly applying to the electronic data file rules determined by selection of the document form. Yankovich discloses applying business rules to a file that are determined by the particular form selected (See Yankovich, Figure 4, Column 3, lines 50-67, and Column 4, lines 1-9). Tonkin, Matsuo, Allen, and Yankovich are analogous art because they are from the same field of endeavor of processing documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the rules of Yankovich with the method of Tonkin, Matsuo, and Allen. The motivation for doing so would have been to determine the form flow or routing associated with the purpose of a particular form (See Yankovich, Column 3, lines 63-66). Therefore, it would have been obvious to combine Yankovich with Tonkin, Matsuo, and Allen for the benefit of determining the form flow or routing associated with the purpose of a particular form to obtain the invention as specified in claim 3.

As per claims 4 and 5, Tonkin, Matsuo, Allen, and Yankovich disclose the limitations of claim 3 as described above. Tonkin also discloses classifying the document component into one of a set of document component types that are permitted under the form rules for the selected document form and verifying that the document

component conforms to the form rules for the document component type into which the document component has been classified (See Tonkin, Page 5, paragraph 0070).

As per claim 6, Tonkin, Matsuo, Allen, and Yankovich disclose the limitations of claim 4 as described above. Tonkin also discloses prompting a user of the controller to input required attributes for the document component type into which the document component has been classified (See Tonkin, Figure 5B, and Page 4, paragraphs 0054-0055).

As per claim 7, Tonkin, Matsuo, Allen, and Yankovich disclose the limitations of claim 4 as described above. Tonkin also discloses displaying a list of each of the document component nodes created as sub-nodes of the document node together with an indication of the document component type into which the contents of each document component node has been classified (See Tonkin, Figure 5F, and Page 5, paragraphs 0065-0066).

7. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1) and Matsuo (U.S. Patent 6,775,729 B1) as applied to claim 1 above, and further in view of Simpson (U.S. Patent 6,559,965 B1).

As per claims 36 and 37, Tonkin, Matsuo, and Allen disclose the limitations of claim 1 as described above. Tonkin, Matsuo, and Allen do not disclose expressly facilitating two-way communication concerning job status between at least one inventory

system and at least one printer. Simpson discloses a method of providing direct, two-way communications between a print client, such as an inventory system, and a printer (See Simpson, Column 2, lines 56-59). Tonkin, Matsuo, Allen and Simpson are analogous art because they are from the same field of endeavor of processing documents. While Simpson does not expressly include a two-way communication method for finishers, Matsuo discloses that finishers, like printers, may be controlled by a controller (See Matsuo, Column 6, lines 48-49, and Figure 1, element 106). At the time of the invention it would have been obvious to one of ordinary skill in the art to include the two-way communications method of Simpson with the document production system of Tonkin, Matsuo and Allen. The motivation for doing so would have been to receive job status directly without using a job status agent to poll the printer or finisher, thereby creating unnecessary network traffic. Therefore, it would have been obvious to combine Simpson with Tonkin, Matsuo and Allen for the benefit of allowing for the receipt of job status information directly without using a job status agent to poll the printer or finisher thereby creating unnecessary network traffic to obtain the invention as specified in claims 36 and 37.

Response to Arguments

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Farrell (U.S. Patent 6,873,426 B1) discloses a method and apparatus to provide alternate or abstract finishing to a print job.
- Sekiwawa (U.S. Patent 6,430,711 B1) discloses a system and method for monitoring the state of a plurality of machines connected via a computer network.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
3/1/2006